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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,354	01/05/2004	Subhakar Dey	BP0306-US	2231

23544 7590 03/26/2007  
APPLIED BIOSYSTEMS  
500 OLD CONNECTICUT PATH  
FRAMINGHAM, MA 01701

EXAMINER
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SACKEY, EBENEZER O

ART UNIT	PAPER NUMBER
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1624

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/751,354

Applicant(s)

DEY ET AL.

Examiner

EBENEZER SACKY

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-15,18,19,21,22,25-29,32,34-42 and 47-54 is/are pending in the application.
- 4a) Of the above claim(s) 25-29,32,34-42,45 and 47-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-15,18,19,21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 08/11/04, 09/22/06, 01/19/07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

This is in response to applicant's remarks filed on 09/26/06.

#### **Status of the Claims**

Claims 1-4, 6-15, 18-19, 21-22, 25-29, 32, 34-42, 45 and 47-54 are pending.

#### ***Specification***

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

#### ***Information Disclosure Statement***

Receipt of the Information Disclosure Statement filed on 08/11/04, 09/22/06 and 01/19/07 respectively is acknowledged. Signed copies of the 1449 are attached herewith.

#### ***Response to Restriction***

Applicant's election with traverse of Group I, claims 1-24 (in part) in the reply filed

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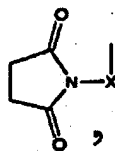
on 09/26/06 is acknowledged. The traversal is on the ground(s) that a restriction within a claim or claims is in conflict with 35 U.S.C. 112 and inconsistent with the decisions of *In re Weber*, *In re Haas*, *In re Harnisch* and/or *In re Hozumi*. This is not found persuasive because there is nothing in the "112, statute" or any other statute, which forbids restriction within a claim. Weber, cited by applicants dealt with a rejection of claims under 35 USC 121 and **not** on the propriety of a requirement to restrict.

Restriction is proper where there is lack of unity of invention and such is not affected by the manner of claiming i.e., in separate claims or within a single claim. Note 37 CFR 1.141(a), which states two or more independent, distinct inventions, may not be claimed in one application. One application includes the possibility of the separate inventions appearing in one claim. This is also consistent with PCT Rule 13.3 for PCT cases entering the national stage. Additionally, applicants have not argued that the various groups are indistinct and there is nothing in the MPEP, which precludes a restriction of independent and distinct inventions within a claim. The Markush claim is generic to a plurality of distinct species encompassing compounds that have acquired a separate status in the art. Lastly, the restriction provided herein is based on 35 USC 121, thus, *Harnish*, *Weber*, *Hozumi*, *Haas* are again all case laws drawn to improper Markush rejections under 35 USC 121 and **NOT** restrictions under 35 USC 121.

Instantly, the restriction within Markush group of claim 1 is based on the distinctiveness of the vastly grouped species having disparate classifications and status in the art. Applicants have not provided any evidence to the contrary. Also note the claims as presented are separately classified based on the presence of the LG group.

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New claims 50-54 are not within the same scope of the elected group (claims 1-



4, 6-15, 18-19 and 21-22 (in part) where LG is that is 1-methoxypyrrolidine-2,5-dione the 1-methylthiopyrrolidine-2,5-dione depending on whether X is oxygen or sulfur. Claims 25-29, 32, 34-42, 45, 47-49 and new claims 50-54 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to non-elected invention.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6-15, 18-19 and 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. The use of the term "comprising" consistently in the claims render the claims indefinite because comprising is an open-ended word, which permit the inclusion of unrecited elements. The use of the term comprising to introduce claimed structure means that the ingredients covered by these claims may involve more elements than those positively recited. *Ex parte Gottzein et al.*, 168 U.S.P.Q. 176 (PTO Bd. App. 1969). Also see *Ex parte Davis et al.*, 80 U.S.P.Q. 448 (PTO Bd. App. 1948).

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Claims, especially compound claims should be defined as ---consisting of ---.

2. The phrase "leaving group of an active ester" is of indeterminate scope because it is not clear what the metes and bounds of the phrase is. From a reading of the specification, only compounds on page 15 of the specification are cited (see page 15, lines 9-10). However, the phrase is not limited to those compounds. Correction is required. Correction is required.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704.

The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached on (571) 272-0661. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is

(571) 272-1600.

EOS

March 9, 2007

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James O. Wilson  
Supervisory Patent Examiner  
Art Unit 1624, Group 1600  
Technology Center 1



GOLAM M. M. SHAMEEM, PhD  
PRIMARY EXAMINER